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Appl. No. 10/773,761
Amtd. dated January 16, 2007
Reply to Office Action of December 14, 2006

JAN 16 2007

PATENT

REMARKS/ARGUMENTS

Claims 42 and 64-66 have been revised to correct clerical informalities without altering the scope of the claims. No new matter has been introduced, and entry of the above revised claims is respectfully requested.

Reconsideration and modification or withdrawal of the Restriction Requirement is respectfully requested in light of the following remarks.

The Restriction Requirement asserts the following Groups:

Group I, claims 7-11, 15-19, 22, 24-28, 31, 33-35, 38, 42, and 49-63;

Group II, claims 7-9, 12-13, 15-17, 20-22, 24-26, 29-31, 33-34, 36-37, 42, and 58-60;

Group III, claims 33-35, 38, 42, and 59-60;

Group IV, claims 33-34, 36-37, 42, and 59-60; and

Group V, claims 7-9, 15-17, 22, 24-26, 31, 58, and 64-66.

Claims 6, 14 and 23 are alleged to link Groups I, II and V while claim 32 is alleged to link Groups I through JV.

The Restriction Requirement further states that "[u]pon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability..." (see bridging paragraph, pages 9-10 of the Restriction Requirement).

Applicants understand the above to indicate that should Group I or Group II or Group IV be elected, linking claims 6, 14, and 23 will be examined with the elected Group and should the linking claims be found allowable, the claims of the remaining Groups will be rejoined. Similarly, Applicants understand that should any one of Groups I through IV be elected, linking claim 32 will be examined with the elected Group and should the linking claims be found allowable, the claims of all remaining Groups will be rejoined.

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Applicants note, however, that there appears to be no recognition that if Groups I, II and V are linked while Groups I through IV are linked, then Groups V and I through IV must also be linked. Therefore, if Groups I, II and V are rejoined, then the correspondingly linked claims of Groups I through IV must also be rejoined. If this understanding is incorrect, Applicants respectfully request clarification and an explanation in the next Official Communication.

Additionally, and should the above understanding be incorrect, Applicants respectfully traverse the assertion of Groups I, II and V as separate inventions that are "linked inventions." Applicants point out that the alleged separation of the claims into these three Groups appears to reflect a failure to recognize *the presence of genus claims*. For example, and contrary to the asserted Restriction Requirement, claims 6-9, 14-17, 22-26, 31-34, and 58-60 are *genus claims that do not require a feature of detection by polynucleotide, protein, or methylation status as alleged in the restriction requirement*.

The fact that these claims appear in two or more of the asserted Groups as presented in the Restriction Requirement (and listed above) further supports the fact that these claims are genus claims. For example, many of these claims are listed in all three of Groups I, II and V or both of Groups III and IV.

The alleged separation of the claims into these various Groups is thus a separation into the alleged species of detection by nucleic acid, polypeptide, or methylation status, *but without recognition of the genus claims*.

Recognition of the presence of genus claims is important because Applicants regard the genus as their invention. Any attempt to restrict the genus to be merely species thereof would deny Applicants the ability to seek claims directed to what they regard as the invention. See *In re Weber* (580 F.2d 455, 198 USPQ 328 (CCPA 1978)) and *In re Haas* (580 F.2d 461, 198 USPQ 334 (CCPA 1978)), and the discussion at MPEP 803.02. These decisions clearly set forth that a restriction requirement cannot be used to divide a single claim, such as a genus claim. Therefore, and by way of example, claims 6-9, 14-17, 22-26, 31-34, and 58-60 cannot be divided by restriction.

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In light of the above arguments, and should the understanding of the prosecution of "linked inventions" indicated above be incorrect, Applicants respectfully request reconsideration and modification of the instant Restriction Requirement in favor of one group comprising the pending claims with recognition of at least claims 6-9, 14-17, 22-26, 31-34, and 58-60 as genus claims.

In the event that the above understanding regarding "linked inventions" be correct, or the Restriction Requirement is nevertheless maintained, Applicants elect Group I, claims 7-11, 15-19, 22, 24-28, 31, 33-35, 38, 42, and 49-63, with traverse for the reasons provided above.

Additionally, and with respect to the Requirement for "one specific polynucleotide/polypeptide combination to which the claims will be restricted", Applicants again respectfully elect the combination of HoxB13 expression and IL17BR expression as a ratio thereof. This combination is reflected in claims 6-31, 52-55, 58, and 61-66 for example. In light of the additional comments in the Restriction Requirement, Applicants elect SEQ ID NO:6 as a representative HoxB13 sequence and SEQ ID NO:1 as a representative IL17RB sequence in the combination.

Applicants point out that contrary to the assertions in the Restriction Requirement, the sequences featured in claims 49-50 and 52-57 are all either those of HoxB13 or IL17RB as encompassed by the genus claims. Accordingly, and because of the presence of genus claims, the attempt in the Restriction Requirement to assert that they are "different and distinct" is an improper attempt to avoid the standards reflected in *In re Weber* (580 F.2d 455 and *In re Haas* as well as the discussion at MPEP 803.02.

Therefore, Applicants respectfully submit that contrary to the characterization in the Restriction Requirement, the asserted "non-standard" requirement for election of subject matter by sequence identifier is only proper if presented as a proper "election of species". Otherwise, it is an improper attempt to restrict within a genus claims.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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